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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/595,440	04/19/2006	Daisuke Itoh	WAKAB81.003APC	9670

20995 7590 08/22/2008  
KNOBBE MARTENS OLSON & BEAR LLP  
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IRVINE, CA 92614

EXAMINER
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ZHU, WEIPING

ART UNIT	PAPER NUMBER
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1793

NOTIFICATION DATE	DELIVERY MODE
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08/22/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

jcartee@kmob.com  
eOAPilot@kmob.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/595,440	<b>Applicant(s)</b> ITOH ET AL.	
	<b>Examiner</b> WEIPING ZHU	<b>Art Unit</b> 1793	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 8/15/2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18, 20-22 and 24-28 is/are pending in the application.
- 4a) Of the above claim(s) 3-14, 16-18, 20-22 and 24-28 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2 and 15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Status of Claims***

1. Claims 1, 2 and 15 are currently under examination.

Applicant's election with traverse of Invention I, Claims 1, 2, 4 and 15 in the reply filed on June 20, 2008 is acknowledged. The examiner would like to thank the applicant for pointing out that Claim 4 should belong to Invention II, since it depends on Claim 3. Therefore, Claim 4 has been regrouped to Invention II.

The traverse is on the ground(s) that the opinion in the International Preliminary Report as to the unity of the invention under PCT Rule 13.1 should be applied to the instant National Stage application. This is not found persuasive. As stated in the Office action dated June 2, 2008, the common technical feature in all groups is the fine metal particle. This element cannot be a special technical feature under PCT Rules 13.2 because the element is shown in the prior art. JP 2002-334618 discloses a fine metal particle having an average particle diameter of 100 nm or less (abstract), which is substantially identical to the claimed fine metal particle. Inventions I-VII lack the same or corresponding special technical features. Therefore unity of invention is lacking and restriction is appropriate. Besides to the contrary of the applicant's assertion, the examiner is entitled to make a restriction requirement in a National Stage application when the unity of the application is lacking. See MPEP 1893.03(d).

The requirement is still deemed proper and is therefore made FINAL.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1, 2 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2002-334618 A.

With respect to claims 1, 2 and 15, JP ('618 A) discloses (paragraphs [0016]-[0018], machine translation) a fine metal particle comprising gold, silver and copper in the form of a dry powder having an average particle size of 1 to 100 nm, wherein the surface of the particle is covered with one or more compounds containing a nitrogen, an oxygen or a sulfur atom (e.g. carboxylic acids as claimed in the instant claim 15 (paragraph [0034], machine translation). JP ('618 A) further discloses that the content of the compound ranges from 5 to 100 parts based on 100 parts by mass of the fine metal particles (paragraph [0036], machine translation). The particle size range of the metal particle and the compound content range of JP ('618 A) overlap the claimed ranges respectively. A prima facie case of obviousness exists. See MPEP 2144.05 I. It would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the claimed ranges within the disclosed ranges of JP ('618 A) with expected success, because JP ('618 A) discloses the same utility over the entire disclosed ranges.

The claimed treatment limitations in the instant claims 1 and 15 are process limitations in product-by-process claims. Even though product-by-process claims are

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limited by and defined by the process, determination of patentability is based on the product itself. JP ('618 A) discloses a fine metal particle, which reasonably appears to be only slightly different than the respective claimed product in the product-by-process claims. A rejection based on section 103 of the status is eminently fair and acceptable. See MPEP 2113.

### ***Conclusion***

3. This Office action is made non-final. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Weiping Zhu whose telephone number is 571-272-6725. The examiner can normally be reached on 8:30-16:30 Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 571-272-1244. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Roy King/  
Supervisory Patent Examiner, Art  
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WZ

8/15/2008